

REMARKS

1. Applicant thanks the Office for its gracious assistance provided during a telephone interview on October 26, 2009. During said interview, Applicant communicated its belief that at least the rejections of Claims 5, 6, 7, and 8 were improper, pointing out citations from the prior art in support of its position. The Office agreed to take Applicant's contentions under advisement. Agreement was not reached.

2. **DOUBLE PATENTING**

Claims 5-11, 16-22, 27-34, 36 and 38 are rejected under the doctrine of obviousness-type double-patenting as being unpatentable over Claims 1-16, and 18-24 of U.S. patent no. 6,760,580. Applicant respectfully disagrees. Nonetheless, in the interest of advancing prosecution of the Application, Applicant submits herewith a terminal disclaimer for the '580 patent. The present rejection is therefore deemed overcome.

3. **35 U.S.C. § 112**

Claims 4-11, 15-22 and 26-39 are rejected under 35 U.S.C., 2nd ¶ as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More particularly, the term "user" is alleged to be unclear. The Office alleges that the "user's" role is unclear. Applicant respectfully disagrees. The Office cites an exemplary case of a user of a mobile unit messaging himself. However, such a use case is nonsensical and therefore merits no serious consideration. In the case of the user being someone sending a message from another device, it is unnecessary to identify the user as being a user of a particular device because the invention is not directed to exchanging messages between a mobile unit and a user of a particular type of device. Wherever it is necessary in the Claims to distinguish the user from a user of the mobile unit, the user of the mobile unit is so identified. Accordingly, the present rejection is deemed improper. Nonetheless, in the interest of

advancing prosecution of the Application, Applicant amends each occurrence of the term "user" to "sender". Support for the amendment is implicit in the Claims. In the independent Claims, it is apparent that the "user" is the party sending a message to the mobile unit, therefore, it is reasonable to identify the party as a "sender."

Claims 11, 22, 23 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention because the use of the term "interest" is alleged to be unclear. Applicant respectfully disagrees. A user of the mobile device may be interested in receiving a message, in which case the mobile-device user desires to receive the message; or the mobile-device user is uninterested, in which case the mobile-device user does not desire to receive the message. Nonetheless, in the interest of advancing prosecution of the Application, Applicant amends each occurrence of the term "interest" to "desire". Because "interest" and "desire" are close synonyms, support for the amendment is implicit in the Claims.

Additional amendments have been made to several of the Claims to increase their clarity and eliminate unnecessary verbiage.

4. **35 U.S.C. § 101**

Claims 15-19, 21-22 and 36-37 are rejected as being directed to non-statutory subject matter. The subject Claims are directed to a computer program product. The Office alleges that because the Specification describes a mode of implementing the invention as computer programming, that the "computer program product" of Claim 36 is necessarily nothing more than a program. Applicant respectfully disagrees. Applicant first notes that the Claim explicitly describes the "computer program product" as comprising a tangible medium having computer-readable code embodied thereon. Accordingly, the plain language of the Claim clearly describes an article of manufacture rather than a computer program. Additionally, the Specification does not describe a "computer program product" as a computer program. The mention of computer programming merely describes an approach by which the computer-readable

instructions could be written. It is Applicant's position that an ordinarily-skilled practitioner in the data processing arts would readily understand that a "computer program product" necessarily includes a tangible medium. Nonetheless, in the interest of advancing prosecution of the Application, Applicant amends the specification to explicitly describe that a "computer program product" constitutes a tangible medium having computer-readable instructions embodied thereon. Support for the amendment to the specification is found in the Claims-as-filed.

5. **35 U.S.C. § 102**

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1989)." "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimus verbis* test, *i.e.* identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)." MPEP § 2131.

Claims 34-35, 7, 8, 10 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,134,432 ("Holmes").

Claim 34: The Office relies on Holmes, col. 5, lines 2-15 as teaching "transmitting the message with the included [reserved] temporarily associated routing codes to the mobile device." Applicant respectfully disagrees. While the citation describes transmission of a message to a mobile device with a temporarily-assigned routing code, the routing code assigned is not from a plurality of reserved routing codes. Rather, as described at col. 5, ll. 4-5, "the gateway may create a new, temporary and unique reply MSISDN associated with the reply address" (emphasis added). Thus, it appears that, each time a sender sends a message to a mobile device, the gateway, rather than assigning a routing code from a plurality of routing codes reserved for the purpose, creates a reply MSISDN anew. The present rejection is therefore deemed improper.

Claim 35: In view of the foregoing regarding Claim 34, the present rejection is deemed improper.

Claim 7: In view of the foregoing regarding Claim 34, the present rejection is deemed improper. Additionally, the Office relies on Holmes, col. 5, lines 2-15 as teaching "replying to said received message by means of a 'reply' function on said mobile unit." Applicant respectfully disagrees. There is absolutely no mention of a 'reply' function in the citation.

Claim 8: In view of the foregoing regarding Claim 34, the present rejection is deemed improper. The Office relies on Holmes, col. 5, lines 56-57 as teaching "wherein assignment of a routing code to said sender persists for the duration of a user session." Applicant respectfully disagrees. The citation actually describes that the assignment persists "for the life of the message." The life of the message and the duration of the user system inherently have nothing to do with each other. If a message is deleted before the user session is terminated, the life of the message is shorter than the user session. If a message is saved, the life of the message persists beyond the user session. Accordingly, there is no teaching in the citation of the subject matter of Claim 8.

Claim 10: In view of the foregoing regarding Claim 34, the present rejection is deemed improper.

In view of the foregoing, the present rejection of Claims 34-35, 7, 8 and 10 is deemed improper. The same Claims are therefore deemed allowable over Holmes under 35 U.S.C. § 102. In view of their dependence from an allowable parent claim, Claim 24's remaining dependent Claims are deemed allowable without any separate consideration of their merits.

In spite of the foregoing, in the interest of advancing prosecution of the Application, Claim 34 is amended to describe "sender for the duration of the user session on said mobile device", incorporating the subject matter of Claim 8, with Claim 8 being cancelled from the Application. Additional support for the amendment is found at least in the Abstract and at least at ¶¶ 0014 and 0051 in U.S. patent application pub. no. 2004/0157586. Thus, even if the rejection of

Claim 34 were not improper, the incorporation of the allowable subject matter of Claim 8 would render Claim 34 allowable, overcoming the present rejection.

Claims 36-37, 18-19, 21 and 38-39, 29-30 and 32 are rejected on the same basis as Claims, 34-35, 8-9 and 10 and are thus allowable for the same reasons that Claim 34 and dependents are allowable. In view of their dependence from allowable parent Claims, remaining dependent Claims of Claims 36 and 38 are deemed allowable without any separate consideration of their merits.

Nonetheless, Claims 36 and 38 are amended in the same fashion as Claim 34, respectively incorporating the subject matter of Claims 19 and 30. Therefore, even if the rejection of Claims 36 and 38 were not improper, the same would be overcome by the present amendment.

In spite of the foregoing, Applicant contributes the following comments regarding the remaining dependent Claims:

6. 35 U.S.C. § 103

Claims 4-6, 15-17 and 26-28 are rejected as being unpatentable over Holmes in view of U.S. patent no. 6,430,604. Applicant notes that Ogle's only contribution to the combination is an "instant messaging system." Accordingly, the greater share of Applicant's remarks below is a continuation of its remarks above regarding Holmes.

Claim 5: The Office relies on Holmes, col. 5, ll. 30-33 as teaching or suggesting "capturing said user's personal identifier by said instant messaging system." Applicant respectfully disagrees. The citation describes the assignment of individual client ID's by a LAN administrator. The instant messaging system is not involved in any way in the assignment of the client IDs.

The Office relies on Holmes, col. 5, ll. 33-36 as teaching or suggesting "assigning a routing code to said user's sender's personal identifier by said instant messaging system." Applicant respectfully disagrees. The citation is a continuation of the above teaching describing assignment by a LAN administrator of MSISDNs to individual clients. Applicant also notes that the

assignment is permanent, as described at col. 5, ll. 31-33. Thus, the association of the MSISDN to the client as described in the citation is permanent rather than temporary. Applicant amends Claim 5 to explicitly describe that it is the instant messaging system that assigns the routing code to the sender's personal identifier. Such teaching is already implicitly described in the claim since it occurs after the message is received at the instant messaging system and before the message is sent to the sender. Accordingly, Claim 5 provides implicit support for the clarifying amendment. The Office relies on Holmes, col. 5, ll. 40-45 as teaching or suggesting "returning notice of said assignment to said mobile unit." Applicant respectfully disagrees. The combination therefore contains no mention whatsoever of returning notice of an assignment to the mobile unit. Thus, the present rejection of Claim 5 is deemed improper. The foregoing remarks apply equally to Claims 16 and 27.

Claim 6: In view of the above remarks regarding Claim 5, the present rejection is deemed improper. The foregoing remarks apply equally to Claims 17 and 28.

Claims 9, 20 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Holmes in view of MPEP § 2144. 06. Applicant strenuously objects to the Examiner's reliance on the above-cited MPEP section as a basis for the present rejection, apparently in an attempt to avoid the necessity of demonstrating that the prior art does, in fact, teach or suggest the subject matter of Claims 9, 20 and 31. It is Applicant's belief that the Examiner seriously misunderstands the content of the citation. "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose...." MPEP § 2144. 06(l) quoting *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (emphasis added). Accordingly, MPEP § 2144. 06 lightens the Examiner's burden in making a showing of a suggestion or motivation to combine teachings from the prior art. However, the cited legal precedent specifically refers to "what is taught by the prior art" (emphasis added). It does not refer to an Examiner's unsupported assertion of what is taught by the

prior art. In other words, the Examiner's apparent belief that citation to MPEP § 2144.06 is an adequate substitute for documentary evidence of what the prior art teaches is specifically shown to be incorrect by her own citation. In addition, "assertions of . . . specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. MPEP § 2144.03(A) quoting *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-2. Here, the Examiner has made an assertion that a particular claim feature is well known in the art, while failing to provide documentary support for the assertion, as required by the law. Accordingly, the present rejection is deemed improper. Applicant respectfully requests that the Examiner provide documentary evidence in support of her assertion of what the prior art teaches.

Claims 11, 22 and 33 are rejected as being unpatentable over Holmes in view of U.S. patent no. 6,947,396 ("Salmi") and further in view of MPEP § 2144.06. Applicant respectfully disagrees. In view of the foregoing remarks regarding the Examiner's misguided reliance MPEP § 2144.06, the present rejection is deemed improper.

7. The foregoing amendments are made solely for the sake of expediency, in the interest of advancing prosecution of the Application. The same do not indicate Applicant's agreement with the Office's position, nor do they reflect intent to forsake claim scope. In fact, Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to in future submissions to the Office.

8. For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

CONCLUSION

In view of the foregoing, the Application is deemed in allowable condition. Accordingly, Applicant respectfully requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions regarding the Application, he is invited to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,



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